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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,785	08/03/2001	Thomas Lopatic	14616	7412

7590   05/06/2005

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EXAMINER
BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/921,785	LOPATIC, THOMAS
	Examiner	Art Unit
	Bradley B. Bayat	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *27 December 2004*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-17* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-17* is/are rejected.

7) ☒ Claim(s) *9-17* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some *   c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

Applicant's election without traverse of Group I: Claims 1-17 in the reply filed on 27

December 2004 is acknowledged.

Status of Claims

Applicant amended claims 4, 5 and 8-17 and withdrew claims 18-75 in the above

referenced response. Thus, claims 1-17 are presented for examination on the merits.

Claim Objections

Claims 9-17 are objected to because of the following informalities: Although the

applicant preliminarily corrected the improper multiple dependencies of claims 9-17, the

language "according to one of the claims…" was not properly amended to reflect the correction.

Furthermore,

In light of the preliminary amendment, applicant is informed that claim 3 and 7 remain

dependent on claims 1 or 2 and 5 or 6, respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Claim 5 recites the limitation "said modifying" as part of step (d).   There is insufficient

antecedent basis for this limitation in the claim. Moreover, the further characterization of this

step is unclear and confusing since applicant recites "…information extracted from at least part

of data of one or more initial and/or intermediate and/or final states of the creation process."

Applicant's limitation refers to either a beginning, middle and/or end state of the creation of a

software product. It is unclear whether the applicant is referring to execution of code at those

times, whether there is a temporal connection as to execution of software, and whether "creation"

is in actuality referring to initial development of the software, creation of the license to use the

software or modification of each phase during execution of the software license. Applicant must

particularly point out and distinctly claim the subject matter which applicant regards as the

invention. Due to their dependency on claim 5, claims 6-17 are also rejected under 35

U.S.C. 112, second paragraph.

Furthermore, the preamble of independent claim 5 recites "a method for software license

management and online software license enforcement," wherein the preamble of dependent

claims 6-17 recite "a method of modifying one or more files of a software product." This

inconsistency renders the claims indefinite as failing to distinctly claim the subject matter

applicant regards as the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Fucarile et

al. (hereinafter Fucarile), US 6,766,305 B1.

As per the following claims, Fucarile discloses:

1. A method for software license management and online software license enforcement

comprising the steps of:

a) providing individual licenses for regulating the use of a software product (column 5,

lines 37-41; figure 3, 301),

b) controlling a transfer of licenses (column 5, lines 45-58; figure 3, 302),

c) providing individualized copies of said software product for download (column 8, lines

1-4; figure 3, 309), and

d) monitoring an execution of each individualized copy of said software product in

agreement with the individual license terms (column 6, line 29-column 7, line 5; figure 3, 307,

figure 4 and associated text).

2. A method for software license management and online software license enforcement

according to claim 1, characterized in that said individualizing step comprises embedding

information in said individualized copies of said software product (column 14, lines 50-57).

3. A method for software license management and online software license enforcement according to claim 1 or 2, characterized in that said individualizing step generates a uniquely individualized copy of said software product for each download (figure 3, 300 Unique ID).

4. A method for software license management and online software license enforcement according to claim 1, characterized in that each subject joining the procedure of said software license management and online software license enforcement is subject to register prior to being granted access (column 5, lines 33-39, program or plug-in loaded).

5. A method for software license management and online software license enforcement comprising the steps of:

a) providing individual licenses for regulating the use of a software product (column 5, lines 37-41; figure 3, 301),

b) controlling a transfer of licenses (column 5, lines 45-58; figure 3, 302),

c) providing individualized copies of said software product for download (column 8, lines 1-4; figure 3, 309), and

d) monitoring an execution of each individualized copy of said software product in agreement with the individual license terms characterized in that said modifying is at least partly based on information extracted from at least a part of data of one or more initial and/or intermediate and/or final states of the creation process of said software product (column 6, line 29-column 7, line 5; figure 3, 307, figure 4 and associated text).

6. A method of modifying one or more files of a software product, according to claim 5, characterized in that said modifying comprises embedding information in at least one of said files (column 14, lines 50-57).

7. A method of modifying one or more files of a software product according to claim 5 or 6, characterized in that said data comprise data of one or more object files generated during the creation process of said software product (column 6, lines 53-67).

8. A method of modifying one or more files of a software product according to claim 5, characterized in that said data comprise data of the debug information generated during the creation process of said software product (figure 10 and associated text).

9. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said data comprise data of the relocation information generated during the creation process of said software product (column 13, lines 3-10).

10. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said modifying is carried out on one or more executable files of said software product (column 14, lines 1-25).

11. A method of modifying one or more files of a software product according to one of the

claims 5, characterized in that said modifying comprises a modification of the arrangement of the

subroutines within said software product (column 14, lines 11-21).

12. A method of modifying one or more files of a software product according to one of the

claims 5, characterized in that said modifying comprises a modification of the arrangement of the

variables within said software product (figure 3, 304-310).

13. A method of modifying one or more files of a software product according to one of the

claims 5, characterized in that said modifying comprises inserting data and/or code between any

two subroutines within said software product (column 14, lines 50-57).

14. A method of modifying one or more files of a software product according to one of the

claims 5, characterized in that said modifying comprises inserting data and/or code between any

two variables within said software product (column 14, lines 50-57).

15. A method of modifying one or more files of a software product according to one of the

claims 5, characterized in that said modifying comprises inserting data and/or code into the code

of one or more subroutines within said software product (column 14, 1-25).

16. A method of modifying one or more files of a software product according to one of the

claims 5, characterized in that data and/or code for testing the integrity of one or more parts of

one or more modified files is embedded within said software product (column 14, line 34-

column 15, line 19).

17. A method of modifying one or more files of a software product according to one of the

claims 5, characterized in that said modifying comprises at least embedding a part of a piece of

verification software (figure 3, 305 verification phase).

Examiner has pointed out particular references contained in the prior arts of record in

the body of this action for the convenience of the applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply as well. It is respectfully requested from

the applicant, in preparing the response, to consider fully the entire references as potentially

teaching all or part of the claimed invention, as well as the context of the passage as taught by

the prior arts or disclosed by the examiner.
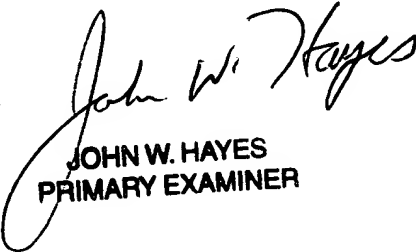
Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The

examiner can normally be reached on Tuesday-Friday 8am-6: 30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbb

JOHN W. HAYES
PRIMARY EXAMINER